

externally threaded member in a manner whereby each of said pipe dies are
slidably captured within said lower tong jaw;

d) applying torque to each of said means of positioning said pipe dies sufficiently
to grip said coupling members

e) rotating said lead screw thereby pivotally applying torque to said lower tong
jaw while holding said upper tong jaw fixed relative to said lower tong jaw.

19. (Currently amended Original) The method according to claim 18 wherein said method further comprises the step of positioning a load cell between a portion of said lead screw and said rectangular body and translating applied rotary torque applied to said lead screw to in pounds force readable upon an attached custom torque gauge into applied torque on said coupling.

20. (Original) The method according to claim 19 wherein said method further comprise the step of charting the reading of said gauge relative to applied torque on said pipe joint.

REMARKS

Reconsideration of this application is requested.

Claim 18 is rejected under 35 U.S.C. 102 (b) as being clearly anticipated by Goldschmidt as the reference shows applying torque to a pipe by using a crew to counter rotate two attached sliding jaw wrenches.

With respect to claim 18 having novel structure that is not shown in the prior reference to Goldschmidt, such may be the case, however the claim is not drawn to a new apparatus, but to a new method of applying torque to a pipe, thus ill the steps that must define over the prior art and clearly they do not. Gotdschrnidt performs the same steps for the same purpose, thus the reference anticipates the claimed method steps. The

specific structure of the wrench is noted, but is of no patentable significance in the method steps.

Regarding claim 18:

Applicant is entitled to claim a method for using his invention. There is no rule that stipulates that a method claim must not include structure as a limitation in a patentable step or that such structural limitations cannot be used as novelty in the method of use claim. The cited reference of Gotdschrnidt fails to recite a method of operation utilizing the structure in the instant claim. Simply because the cited reference achieves a similar result with an entirely different apparatus does not anticipate applicant's method using a different apparatus requiring very different steps. As amended claim 18 now includes a number of specific steps that depend on the claimed structure.

The Courts have also ruled that limitations of the claim including its structural limitations may not be negated. The instant claim must be taken as a whole and not dissected for only the elements found in the cited reference.

Regarding Claim 19

"Claim 19 appears to be a method of making or assembling the device and not a method of applying torque".

Applicants have argued that claim 19 is clearly drawn to adding additional structure to the tool, i.e. an assembly step, as part of the method of applying torque to a pipe. This means that every time the method of claim 18 is used for the purpose of applying torque, claims 19 and 20 require that a new wrench be manufactured as these claims are drawn only to the method of assembling the wrench. Clearly this has nothing to do with the method of applying torque to a pipe, thus the claims are indefinite,

Response:

Examiner is making significant presumptions and arguments without supporting evidence. There is no indication in the application that a new wrench would need to be manufactured to obtain an applied torque reading. The load cell could easily be applied externally. However, As amended herein claim 19 further defines the step of translating the torque applied in terms of the number of turns of the lead screw relative to the pounds force observed on a gauge and the use of a calculated chart based on the screw thread size and lead and the length of the tong arms. Therefore, claim 19 involves a novel step unanticipated by the cited reference and does not involve additional structural elements.

Inasmuch as each of the rejections have been overcome by the amendment to the claims and through arguments relating thereto, and all of the examiner's suggestions and requirements have been satisfied, it is respectfully requested that the rejections be withdrawn and that this application be passed to issue.

Should the examiner feel that a telephone conference would advance this application, she is encouraged to contact the undersigned at the telephone number listed below.

Please contact the submitter if any fees are due.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450 Alexandria, VA 22313-1450 on 1-29 2005.



Robert N. Montgomery,